

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

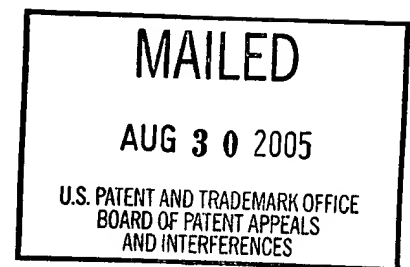
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte THOMAS JAMES KLOFTA, JAMES ANTHONY STAUDIGEL,
and GEORGE ENDEL DECKNER

Appeal No. 2005-2205
Application No. 09/898,880

ON BRIEF



Before SCHEINER, MILLS, and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 20-25, which are all of the claims pending in this application.

The claim 20 is representative of the claims before us and is set forth below:

20. A disposable absorbent article having a film-forming composition disposed on at least a skin-contacting surface of the absorbent article, wherein the composition is substantially anhydrous and is solid or semi-solid at room temperature, the composition comprises:

a. from about 1 to about 80 wt% of a skin conditioning agent selected from the group consisting of petroleum-based emollients; fatty acid esters; polysiloxanes; polyol polyesters; esters or ethers of polyhydroxy alcohols; fatty alcohol esters of polyprotic acids; animal oils, fats, and their derivatives; vegetable oils, hydrogenated vegetable oils, and their derivatives; branched hydrocarbons, fatty alcohol ethers, free sterols, sterol esters and their derivatives; sphingolipids; phospholipids; and mixtures thereof;

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- b. from about 15 to about 50 wt% of a viscosity enhancing agent selected from the group consisting of C12 - C60 alcohols, waxes, fumed silicas, and mixtures thereof;
 - c. from about 1 to about 20 wt% of a film-forming agent selected from of polyalkenes, PVP/alpha-olefin copolymers, acrylic copolymers, and mixtures thereof; and
 - d. optionally, from about 0.01 to about 10 wt% of a skin care ingredient selected from the group consisting of Monographed I actives, Monographed III actives, vitamins, proton donating agents, protease inhibitors, enzyme inhibitors, chelating agents, anti-microbials, skin soothing agents, and mixtures thereof; and
- wherein the composition is resistant to water, wash-off, and rub-off.

The prior art references relied upon by the examiner are:

Roe et al. (Roe)	5,609,587	Mar. 11, 1997
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Wenninger et al., (Wenninger), International Cosmetic Ingredient Dictionary and Handbook, 7th ed., Vol. 1, pp. 26-27, Vol. 2, pp. 1067-1068 (1997)

Grounds of Rejection

Claims 20-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Roe in view of Wenninger.

We reverse this rejection.

DISCUSSION

35 U.S.C. § 103(a)

Claims 20-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Roe in view of Wenninger.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is well-established that the

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conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

It is the examiner's position that (Answer, page 3):

Roe discloses a diaper having a lotioned top sheet comprising a liquid polyol polyester emollient and an immobilizing agent. The disposable absorbent article of the prior art can be sanitary napkins, panti-liners, diapers, incontinence briefs, etc. (col. 4, lines 34-37). The lotion composition comprises (1) a liquid polyol polyester emollient; (2) an immobilizing agent(s) for the liquid polyol polyester emollient; (3) optionally a hydrophilic surfactant; and (4) other optional components ... The skin conditioning agent of the claimed invention is the polyol polyester of the prior art. ... The viscosity agent of the claimed invention is the immobilizing agent (i.e. C₁₂-C₂₂ fatty acids)(col. 18, lines 45-62) or waxes (col. 21, lines 18-25). Within the optional components we find vitamins, skin soothing agents (i.e. applicants claimed skin care ingredients) and film-forming agents (col. 23, lines 27-44). Column 15, lines 49-64 describe that petroleum-based emollients can be employed in the composition. The prior art does not teach the specific film-forming agents as claimed.

To make up for the film-forming agent deficiency, the examiner relies on Wenninger, which discloses the use of acrylate copolymers as film formers and the use of polyethylene as a film-forming agent. Answer, page 4.

The examiner concludes,

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the acrylates [sic] copolymers and polyethylene of Wenninger in the invention of Roe. Column 23, lines 41-44, state "all of these materials are well known in the art as additives for such formulations and can be employed in appropriate amounts in the lotion compositions of the present invention.". Thus it is obvious to combine.

In response, the appellants argue that Roe discloses that (Brief, page 6)

[f]rom the numerous combinations that could be selected from the optional ingredients, one of ordinary skill in the art must first choose to focus on the film forming agents. Then, from a dictionary that lists all the film formers used in cosmetics, one of ordinary skill in the art must then choose Appellants' film formers of polyalkylenes, PVP/alpha-olefin copolymers, and acrylic copolymers.

Appellants conclude, "[t]he Office has failed to establish a *prima facie* case of obvious [sic] since there is nothing in the cited references nor a line of reasoning to suggest combining the references to yield Appellants' claimed invention." Id.

We agree with appellants that the examiner has failed to establish a prima facie case of obviousness on the facts before us. It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996). Moreover, where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls

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within the scope of possible combinations taught therein does not render it unpatentably obvious. See, In re O'Farrell, 7 USPQ 2d 1673 (CAFC 1988).

In our view, the examiner has not clearly established why one of ordinary skill in the art, with knowledge of a large group of optional ingredients described in Roe, would have been specifically motivated to first, select film formers from this large group of optional ingredients, and then select the particular limited group of film formers from the potentially vast number of known film formers. Thus, the examiner has not put forth a sufficient reason, suggestion or motivation to combine the cited references to arrive at the claimed invention. Nor do we find that the examiner has sufficiently established that Roe suggests or leads one of ordinary skill in the art to a formulation of a “substantially anhydrous” film forming composition, as claimed. The entire film forming composition of claim 20 is described to be “substantially anhydrous”, whereas in Roe, only the emollient component of the lotioned topsheet is described as “substantially free of water.” Roe, Col. 15, lines 37-45.

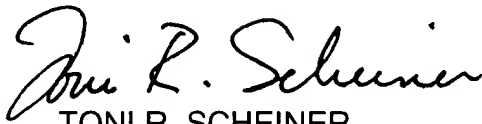
In view of the above, the rejection of claims 20-25 under 35 U.S.C. 103(a) as obvious over Roe in view of Wenninger is reversed.

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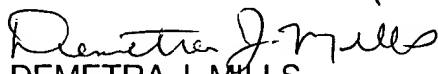
CONCLUSION

The rejection of claims 20-25 under 35 U.S.C. 103(a) as obvious over Roe in view of Wenninger is reversed.

REVERSED



TONI R. SCHEINER
Administrative Patent Judge



DEMETRA J. MILLS
Administrative Patent Judge



ERIC GRIMES
Administrative Patent Judge

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